Supreme Court, U. S.
FILED
DEC 22 1977
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1977.

No. 77-642

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS,

Petitioner,

vs.

DALE R. FLOOK,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

FRANK J. UXA, JR.,
400 East Sibley Boulevard,
Harvey, Illinois 60426,
D. D. ALLEGRETTI,
EDWARD W. REMUS,
ALLEGRETTI, NEWITT, WITCOFF & MCANDREWS,
125 South Wacker Drive,
Chicago, Illinois 60606,
Attorneys for Respondent, Dale R. Flook.

Gunthorp-Warren Printing Company, Chicago • Financial 6-6565

TABLE OF CONTENTS.

	PAGE
Question Presented	1
Argument	2
Conclusion	6

TABLE OF AUTHORITIES.

Cases.

Bernhart and Fetter, Application of, 417 F. 2d 1395 (C. C. P. A. 1969)	5
Chatfield, Application of, 545 F. 2d 152 (C. C. P. A. 1976)	4
de Castelet, Application of, 562 F. 2d 1236 (C. C. P. A. 1977)	4
Flook, Application of, 559 F. 2d 21 (C. C. P. A. 1977)	1
Funk Brothers Seed Co. v. Kalo Inoculant Co., 333 U. S. 127	5
Gottschalk v. Benson et al., 409 U. S. 63	3, 4, 5, 6
Musgrave, Application of, 431 F. 2d 852 (C. C. P. A. 1970)	2
Waldbaum, Application of, 457 F. 2d 997 (C. C. P. A. 1972)	2

Constitution, Statutes and Rules.

United States Constitution, Article I, Section 8, Clause 8	2
28 U. S. C. § 1256	2
35 U. S. C. § 101	2, 4, 5
U. S. Supreme Court Rule 19(1)	4, 6

IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

No. 77-642.

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS,

Petitioner,

vs.

DALE R. FLOOK,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

Respondent, Dale R. Flook, opposes the petition for writ of certiorari to the United States Court of Customs and Patent Appeals.

QUESTION PRESENTED.

Petitioner's statement of the question presented for review is in error. As stated by the Court below, "the issue in this case is whether a claim to a process which *uses* an algorithm to modify a conventional manufacturing system is statutory subject matter under *Gottschalk* v. *Benson*, 409 U. S. 63, 93 S. Ct. 253, 34 L. Ed. 2d 273, 175 U. S. P. Q. 673 (1972) and *Christensen, supra*". *Application of Flook*, 559 F. 2d 21, 22 (C. C. P. A. 1977) (emphasis in original).

ARGUMENT.

The United States Court of Customs and Patent Appeals in a unanimous decision reported at 559 F. 2d 21 (P.[1] Appendix A), reversed the Patent and Trademark Office Board of Appeals and held the subject matter claimed in respondent's patent application (R.[2] 7) to be patentable under 35 U. S. C. § 101. Petitioner, the Acting Commissioner of Patents and Trademarks, seeks review by this Court on writ of certiorari. 28 U. S. C. § 1256. Since the opinion below is in agreement with this Court's previous decisions and since there are no other special and important reasons for review on writ of certiorari, the Petition should be denied.

This case involves patent claims directed to a novel, unobvious and useful method for adjusting alarm limits on process variables associated with a catalytic hydrocarbon conversion process. Mathematical relationships are used in the intermediate steps of respondent's method to determine updated values which are then used in adjusting the alarm limits. When an alarm limit on a process variable is exceeded, a signal is given, *e.g.*, sounded, to warn of possible danger to the hydrocarbon conversion process. Thus, the present invention provides for improved safety and efficiency in the operation of a catalytic hydrocarbon conversion process. As the Patent Examiner agreed (R. 39), this invention is clearly a new and unobvious process which is also useful in the technological arts as called for in 35 U. S. C. § 101[3] and the Constitution.[4]

1. "P." refers to the Petition for Writ of Certiorari to the United States Court of Customs and Patent Appeals filed in the present case.

2. "R" refers to the printed record filed in the Court of Customs and Patent Appeals. Petitioner has indicated that a copy of this record has been lodged with the Clerk of this Court.

3. *Application of Musgrave*, 431 F. 2d 882 (C. C. P. A. 1970); *Application of Waldbaum*, 457 F. 2d 997 (C. C. P. A. 1972).

4. Article I, Section 8, Clause 8 of the Constitution of the United States is as follows:

(Footnote continued on next page.)

Petitioner, focusing solely on the mathematical relationships useful in part to aid in defining respondent's method, proposes a question to this Court which is not presented by the facts of this case. Petitioner's primary contention is that respondent is seeking to patent the mathematical relationships useful in the present method in direct conflict with this Court's decision in *Gottschalk* v. *Benson, et al.*, 409 U. S. 63 (P. 11 and 12).

However, the Petitioner's position is without basis in fact. Respondent does not seek to patent, *i.e.*, wholly pre-empt, the mathematical relationships included in the overall claiming of the invention. Rather, the technologically useful method applies such relationships to modify the operation of a catalytic hydrocarbon conversion process, *e.g.* to improve process safety and efficiency.

This Court in *Benson*, 409 U. S. at 72, came down to the following "nutshell" holding:

> "It is conceded that one may not patent an idea. But in practical effect that would be the result if the formula for converting BCD numerals to pure binary numerals were patented in this case. The mathematical formula involved here has no substantial practical application except in connection with a digital computer, which means that if the judgment below is affirmed, the patent would wholly preempt the mathematical formula and in practical effect would be a patent on the algorithm itself."

The Court below, applying the holding of *Benson* to the facts of the present case stated, 559 F. 2d at 23, as follows:

> "We must then consider whether *Benson* itself excludes the present claims from patentability. *Benson's* proscription was limited by its words to claims which involve a 'mathematical formula' and which 'would wholly pre-empt the mathematical formula.' 409 U.S. at 72, 93 S.Ct. at 257, 175

(Footnote continued from preceding page.)

> The Congress shall have the Power * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries * * *

> U.S.P.Q. at 676. The present claims do not pre-empt the formula or algorithm contained therein, because solution of the algorithm contained therein, because solution of the algorithm, per se, would not infringe the claims. Thus, *Benson's* holding does not render the claims before us unpatentable. The decision of the board is reversed."

Petitioner argues that the holding in the present case is the latest in a series of rulings by the United States Court of Customs and Patent Appeals which rest on a strained interpretation of *Benson*. However, *Benson* holds that patent claims which wholly pre-empt algorithms are unpatentable under 35 U. S. C. § 101. Here respondent merely uses mathematical relationships in the intermediate steps of a claimed method to modify the operation of a hydrocarbon conversion process. No total pre-emption of these mathematical relationships is sought, and none is granted. Thus, the Court below has correctly applied *Benson* in holding respondent's claims patentable under 35 U. S. C. § 101.

In addition, contrary to the implication raised by Petitioner, the Court below is, in fact, refusing to grant patents based on its interpretation of *Benson*. See for example, *Application of de Castelet*, 562 F. 2d 1236 (C. C. P. A. 1977) and the cases cited therein.

Petitioner quotes from the dissent of Judge Rich in *Application of Chatfield*, 545 F. 2d 152 (C. C. P. A. 1976), certiorari denied *sub nom. Dann* v. *Chatfield*, No. 76-1559, October 3, 1977, regarding the importance of settling the question of computer software patentability (P. 10, footnote 10). However, given the present facts, Judge Rich joined in the *unanimous* decision of the Court below to hold that respondent's method is patentable under 35 U. S. C. § 101 in view of *Benson*. The unanimity of the decision below provides a still further indication that this holding is fully consistent with this Court's decision in *Benson*. Additionally, the question presented by this case does not provide any other special and important reasons for granting review on writ of certiorari as required by Rule 19(1) of this Court.

Petitioner contends that the "point of novelty" of respondent's method is the recited mathematical relationships which by themselves are not patentable under 35 U. S. C. § 101 and, therefore, Petitioner contends that respondent's whole method is unpatentable under 35 U. S. C. § 101. Such a restrictive interpretation of the entire claim, by focusing only upon a single element of it, is improper and has been discredited. For example, in *Application of Bernhart and Fetter*, 417 F. 2d 1395 (C. C. P. A. 1969), the United States Court of Customs and Patent Appeals expressly held that the "point of novelty" contention was not correct under the Patent Act and the case law as developed to that time. No subsequent decisions can be cited to the contrary. Petitioner inappropriately notes only this Court's decisions in *Benson* and in *Funk Brothers Seed Co.* v. *Kalo Inoculant Co.*, 333 U. S. 127, which do not address a "point of novelty" position.

Petitioner states that *Benson* holds that "processes applying scientific principles or ideas are to be upheld only when: (1) the process was carried out with a specific apparatus devised to implement the newly-discovered idea, and (2) the claim to a monopoly was confined to a specific end-use or field of art or technology". (P. 15). These restrictive generalities are in no way specified by this Court's precise holding in *Benson* that subject matter which wholly pre-empts a mathematical formula and is, in practical effect, a patent on the algorithm itself is not statutory under 35 U. S. C. § 101. Respondent's method does not wholly pre-empt any mathematical relationships merely because such relationships are defined and used in the claimed methods. Instead, respondent claims as his method invention a novel and useful sequence of steps for controlling at least one variable in a catalytic chemical conversion process, by determining an updated alarm limit for it through the performance of certain specified mathematical calculations, and by then adjusting the alarm limit to its new value.

CONCLUSION.

The Petition should be denied for failure to present any question appropriate to the granting of a petition for writ of certiorari as required under Rule 19 of this Court. The question presented by this case has been properly answered by the unanimous decision of the Court below in full and complete agreement with this Court's decision in *Gottschalk* v. *Benson et al.*, 409 U. S. 63. Respondent submits that no conflict exists between the present case and any of the Court's decisions, in particular, *Benson*. Further, the question presented by this case involves no other special or important reasons for review on Writ of Certiorari as required by Rule 19(1) of this Court. The Petition should be denied.

Respectfully submitted,

FRANK J. UXA, JR.,
400 East Sibley Boulevard,
Harvey, Illinois 60426,
D. D. ALLEGRETTI,
EDWARD W. REMUS,
ALLEGRETTI, NEWITT, WITCOFF
& MCANDREWS,
125 South Wacker Drive,
Chicago, Illinois 60606,
Attorneys for Respondent,
Dale R. Flook.